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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,990	08/06/2003	Dennis Wayne Rice	103864.134US1	7455
28089	7590	05/17/2005	EXAMINER	
WILMER CUTLER PICKERING HALE AND DORR LLP 399 PARK AVENUE NEW YORK, NY 10022			GRAY, LINDA L	
			ART UNIT	PAPER NUMBER
			1734	
DATE MAILED: 05/17/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/634,990

Applicant(s)

RICE ET AL.

Examiner

Linda L. Gray

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 8-6-03, 2-3-04, 6-10-04, 7-7-04, 2-10-05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 34-40, 43-49 and 53-61 is/are rejected.
- 7) ☒ Claim(s) 41, 42 and 50-52 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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**Detailed Action**

**Election/Restriction**

1. Applicant's election with traverse of **claims 34-61** in the reply filed on 2-10-05 is acknowledged. The traversal is on the grounds that the claims emphasize similar limitations relating to a label apparatus and/or method, each including reduction of the label. This is not found persuasive because the basis for restriction is provided in MPEP 806.05(f) for inventions II and I; MPEP 806.05(g) for inventions III and II; and MPEP 806.05(e) for inventions I and III. The requirement is still deemed proper and is therefore made final. **Claims 1-33 and 62-67** are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention.

**Claim Rejections - 35 USC 112**

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the application regards as his invention.

3. **Claims 37-39, 43-45, 49, and 61 are rejected under 5 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**Claim 37**, "the label rolling tool" and "the folding tool" lack antecedent basis.

**Claim 38**, "the folding tool" lacks antecedent basis.

**Claim 39**, "the folding tool" lacks antecedent basis.

**Claim 43**, it is unclear what is meant by the label being folding (L 4 and 7) since claims 34 and 43 do not indicate a means for folding, and although it is clear from the specification that it is the reducing means that folds, claims 34 and 43 do not indicate such to allow for claiming a folding in claim 43. The same applies to rolling in **claim 55**.

**Claim 61**, it is unclear what is intended by "the means for rolling" because such lacks antecedent basis.

**Claim Rejections - 35 USC 102**

**4.** The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless - (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**5. Claims 59-61 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoffmann (US 4,181,555).**

**Claim 59**, Hoffmann teaches a system (Fig 1) for labeling container 17 (c 1, L 1-13) including the following:

- (a) means 40/41 for preparing label 13 for attachment (c 3, L 25, to c 5, L 27),
- (b) means 37/38 for providing a web of intended labels 13 to means 40/41,
- (c) means 28 for applying a surface securing adhesive to at least one surface securing section of label 13 (c 2, L 52, to c 3, L 10),
- (d) means 25 for transporting label 13 to means 28 (c 3, L 1-10), and
- (c) means 20/20 for attaching the at least one surface securing section of label 13 to container 17 wherein the adhesive affixes label 13 to container 17 (c 2, L 52-66).

**Claim 60**, Hoffman teaches the apparatus to be automatic thus teaching means for controlling an operation of the system. **Claim 61**, Hoffmann teaches means 42 (Fig 1) for removing label 13 from means 40/41 which are rollers. Claim 61 is rejected in view of the rejection of claim 61 under 35 USC 112, second paragraph.

**Claim Rejections - 35 USC 103**

**6.** The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**7. Claims 34-36, 38-40, 46-48, and 53-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Voltmer et al. (US 4,502,910) in view of Vijuk (US 6,273,411 B1).**

**Claim 59**, Voltmer et al. teach system 20 for labeling medicinal container 24 (c 2, L 1-7) including the following:

(a) means 101 for applying a surface securing adhesive to at least one surface securing section of folded label 28 (c 1, L 19-37; c 3, L 47-51),

(b) a means for transporting label 28 to means 101 where this means includes hopper 102, plunger 124, and pick-up bar 103 (c 3, L 16-26), and

(c) means 108 for attaching the at least one surface securing section of label 28 to container 24 wherein the adhesive affixes label 28 to container 24 (c 4, L 19-29).

*Although labels 28 of Voltmer et al. are provided for in some manner, Voltmer et al. do not elaborate on how labels 28 are provided. Specifically, Voltmer et al. do not teach that the means for transporting gets labels 28 from a means for reducing labels 28 which prepares labels 28 (in this case, folds into folded labels 28) where Voltmer et al. also do not teach a feeder for the reducing means.*

Vijuk teaches a means for folding web 11 into folded medicinal label 10 (c 1, L 1-9). Specifically, Vijuk teaches means for reducing 153/155 (Figs 7, 12, 16A, and related

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discussion) which prepares labels 10 by folding where Vijuk teaches feeder 151 (Figs 7, 8, and related discussion) for means 153/155.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Voltmer et al. a means for forming labels 28 using the means taught by Vijuk, i.e., that the means for transporting gets labels 28 from a means for reducing labels 28 which prepares labels 28 (in this case, folds into folded labels 28) and a feeder for the reducing means; because it is obvious to replace one means for providing and forming labels 28 (that of Voltmer et al. not specifically disclosed) with an art recognized means (that of Vijuk).

The following is taught by Voltmer et al. though such is not considered to have a positive recitation within the claims because such refers to the material acted upon by the claimed system: "including a medication, comprising at least one of a bottle and a package, with a label providing information regarding the medication to a consumer thereof".

**Claim 60**, Voltmer et al. teach means 132 for controlling system 20 (c L 19-53). **Claim 61**, Voltmer et al. teach means 111 for removing labels 28 from means 101 which is in roll form on 116. Claim 61 is rejected in view of the rejection of claim 61 under 35 USC 112, second paragraph.

**Claims 34-35**, Voltmer et al. teach system 20 for labeling medicinal container 24 (c 2, L 1-7) including the following:

- (a) means 101 for applying a surface securing adhesive to at least one surface securing section of folded label 28 (c 1, L 19-37; c 3, L 47-51), and
- (b) a means for transporting label 28 to means 101 where this means includes hopper 102, plunger 124, and pick-up bar 103 (c 3, L 16-26).

*Although labels 28 of Voltmer et al. are provided for in some manner, Voltmer et al. do not elaborate on how labels 28 are provided. Specifically, Voltmer et al. do not teach that the means for transporting gets labels 28 from a means for reducing labels 28 which prepares labels 28 (in this case, folds into folded labels 28) where Voltmer et al. also do not teach means for applying adhesive to keep label 28 reduced.*

Vijuk teaches a means for folding web 11 into folded medicinal label 10 (c 1, L 1-9). Specifically, Vijuk teaches means for reducing 153/155 (Figs 7, 12, 16A, and related discussion) which prepares labels 10 by folding where Vijuk teaches adhesive applicator 152 (Figs 7, 11, and related discussion) which keeps labels 10 folded.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Voltmer et al. a means for forming labels 28 using the means taught by Vijuk, i.e., that the means for transporting gets labels 28 from a means for reducing labels 28 which prepares labels 28 (in this case, folds into folded labels 28) and a means for applying adhesive to keep label 28 folded because it is obvious to replace one means for providing and forming labels 28 (that of Voltmer et al. not specifically disclosed) with an art recognized means (that of Vijuk).

The following is taught by Voltmer et al. though such is not considered to have a positive recitation within the claims because such refers to the material acted upon by the claimed system: "including a medication, comprising at least one of a bottle and a package, with a label providing information regarding the medication to a consumer thereof". The same applies to **claim 47** and the following sections: customer information, medication information, use instructions, and barcode.

**Claim 36**, Voltmer et al. teach means 132 for controlling system 20 (c L 19-53). **Claims 38-39**, Voltmer et al. modified teach at least two creasing wheel which crease label 28 as label 28 is being folded by the reducing means (Fig 12 of Vijuk, and related discussion). **Claim 40**, in Voltmer et al. pick-up bar 103 is a vacuum pad that enables label 28 to be kept in a secure position during transport (c 3, L 16-28).

**Claims 46 and 48**, Voltmer et al. do not teach the claimed label length and width.

However, However, MPEP § 2144.05 indicates that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation, In re Aller, 220 F.2d 454, 105 U.S.P.Q. 233, 235 (CCPA 1955), and it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Voltmer et al. the optimum length and width for the label and label areas.

**Claim 55**, in Voltmer et al. modified, the label reducing adhesive enables label 28 to be unfolded (i.e., unrolled) and resecured in a folded shape without damaging label 28.

**Claims 56 and 58**, Voltmer et al. teach system 20 for labeling medicinal container 24 (c 2, L 1-7) including the following:

- (a) means 101 for applying a surface securing adhesive to at least one surface securing section of folded label 28 (c 1, L 19-37; c 3, L 47-51),
- (b) a means for transporting label 28 to means 101 where this means includes hopper 102, plunger 124, and pick-up bar 103 (c 3, L 16-26), and
- (c) means 108 for attaching the at least one surface securing section of label 28 to container 24 wherein the adhesive affixes label 28 to container 24 (c 4, L 19-29).

*Although labels 28 of Voltmer et al. are provided for in some manner, Voltmer et al. do not elaborate on how labels 28 are provided. Specifically, Voltmer et al. do not teach that the means for transporting gets labels 28 from a means for reducing labels 28 which prepares labels 28 (in this case, folds into folded labels 28 by rolling and creasers).*

Vijuk teaches a means for folding web 11 into folded medicinal label 10 (c 1, L 1-9). Specifically, Vijuk teaches means for reducing 153/155 (Figs 7, 12, 16A, and related discussion) which prepares labels 10 by folding (with rolling and creasers).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Voltmer et al. a means for forming labels 28 using



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the means taught by Vijuk, i.e., that the means for transporting gets labels 28 from a means for reducing labels 28 which prepares labels 28 (in this case, folds into folded labels 28 by rolling and creasers) because it is obvious to replace one means for providing and forming labels 28 (that of Voltmer et al. not specifically disclosed) with an art recognized means (that of Vijuk).

The following is taught by Voltmer et al. though such is not considered to have a positive recitation within the claims because such refers to the material acted upon by the claimed system: "including a medication, comprising at least one of a bottle and a package, with a label providing information regarding the medication to a consumer thereof".

**Claim 57**, Voltmer et al. teach means 132 for controlling system 20 (c L 19-53).

**Claims 53-54**, Voltmer et al. teach automated device 108 for affixing label 28 to container 24 but does not teach, instead, a robotic arm with a controller.

However, robotic arms with controllers are conventional in the labeling art to ensure a more accurate label placement, and for this reason it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Voltmer et al. a robotic arm with a controller instead of roller 108.

**Allowable Subject Matter**

**9. Claims 37, 43-45, and 49 would be allowable if rewritten to overcome the rejections under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.**

**Claims 41-42 and 50-52 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.**

**10. The following is a statement of reasons for the indication of allowable subject matter:**

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**claim 37:** Voltmer et al. modified do not teach that the reducing means includes a flat, rectilinear device, with a first and second end, with at least one of the first end and second end being attached to a rotation device, the rotation device enabling the reducing means to be rotated along an axis of rotation,

**claim 41:** Voltmer et al. modified do not teach a spring loaded ridge, wherein the spring loaded ridge enables label 28 to be removed from the reducing means without causing damage to label 28,

**claim 42:** Voltmer et al. teach reader 105 which scans for labels 28 to facilitate correct matching of label 28 and container 24 (c 4, L 19-54); however, Voltmer et al. do not teach reader 105 to be a barcode reader which scans a barcode printed on label 28 to facilitate the correct placement,

**claim 43:** Voltmer et al. do not teach a first barcode reader that scans a barcode printed on label 28 before label 28 is folded and a second barcode reader, wherein the first reader scans the barcode after label 28 is folded and wherein the first and second readers facilitate correct matching of label 28 to container 24, and

**claim 50:** although label rejection mechanism, including a disposal assembly, (see JP 5-147636) are conventional in the labeling art to rid a process of defective labels, Voltmer et al. do not allow for and the prior art of record does not teach a mechanism including a pair of needles which are advanced through the label as the label lines on the transport means and a stripper plate which holds the label in place on the transport means as the pair or needles are applied to the label.

**11.** As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

### **Conclusion**

**12.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Linda Gray whose telephone number is (571) 272-1228. The examiner can normally be reached Monday-Friday from 9:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla, can be reached at (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

llg

May 16, 2005

*Linda L. Gray*  
LINDA GRAY  
PRIMARY EXAMINER